



Art Unit: 3102

Double Patenting

1. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

2. Claims 32-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32-38 of copending application Serial No. 08/479335. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims do not substantially differ and it would have been obvious to one of ordinary skill in the art that Applicant is claiming the same invention in both applications.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 32, 33, 35, 37, 39, and 40 are rejected under 35 U.S.C. § 102(a) as being anticipated by Beam.

The rivet-like deformed section 50 is a temporary securing means and positions the cover centrally with respect to the wheel causing it to be spaced from the wheel outboard surface; and with respect to claim 37, the means 50 is considered to be resilient.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7. Claim 34 is rejected under 35 U.S.C. § 103 as being unpatentable over Beam.

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Beam meets all of the limitations of claim 32 as set forth in paragraph 5 above, but does not disclose the use of a hot-melt adhesive. However, to substitute a hot-melt adhesive for the epoxy used by Beam would have been obvious to one of ordinary skill in the art as a suitable functional equivalent to the epoxy.

Allowable Subject Matter

8. Claims 1-31 are allowable over the prior art of record.
9. Claim 38 would be allowable upon the removal of the double patenting rejection.
10. Claim 36 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and the removal of the double patenting rejection.

Response to Amendment

11. Applicant's arguments with respect to claims 32, 33, 34, 35, 37, 39, and 40 are have been considered but are deemed to be moot in view of the new grounds of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Lewis discloses a wheel cover having a temporary and a permanent securing means, but no adhesive. Carter, III discloses a wheel cover having a temporary fastener 40, 42, and a permanent fastener 34, but the cover is not secured directly to the wheel outboard surface by the permanent adhesive means.

13. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.


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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Stormer whose telephone number is (703) 308-1113.

rds
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RUSSELL D. STORMER
PRIMARY EXAMINER
ART UNIT 312
9/1/96